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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/728,239  | 12/03/2003  | Jean-Paul Mardon     | 12928/100021        | 7506             |
| 26646   | 7590        | 05/16/2007           | EXAMINER            |                  |
| KENYON & KENYON LLP<br>ONE BROADWAY<br>NEW YORK, NY 10004 |             |                      | ROE, JESSEE RANDALL |                  |
|   |             | ART UNIT             | PAPER NUMBER        |                  |
|   |             | 1742                 |                     |                  |
|   |             | MAIL DATE            | DELIVERY MODE       |                  |
|   |             | 05/16/2007           | PAPER               |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/728,239             | MARDON ET AL.       |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Jessee Roe             | 1742                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 March 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. 09/647339.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 9 March 2007.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Status***

Claims 1-3 are pending.

### ***Claim Rejections - 35 USC § 103***

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mardon et al. (US 5,648,995) in view of Sabol et al. (US 4,649,023) and Rebeyrolle et al. (US 5,832,050).

Claims 1-3 are rejected on the same grounds as stated in the Office Action of 6 December 2006.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No.6,863,745 on the same grounds as stated in the Office Action of 6 December 2006.

***Response to Arguments***

Applicant's arguments filed 9 March 2007 have been fully considered but they are not persuasive.

First, the Applicant argues that there is no suggestion to combine the references of Mardon et al. ('995), Sabol et al. ('023), and Rebeyrolle et al. ('050). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Mardon et al. ('995) disclose (abstract) a zirconium based alloy with 0.8-1.3 weight percent niobium that is made into tubing sheaths (sheet) for nuclear fuel rods as shown in the table on the following page.

| Element | From Instant Claims | Mardon et al. ('995) | Overlapping range |
|---------|---------------------|----------------------|-------------------|
| Fe      | must be present     | 50 - 250 ppm         | 50-250 ppm        |
| Cr      | -                   | -                    | -                 |
| V       | -                   | -                    | -                 |
| Nb      | 0.8%-1.3%           | 0.8%-1.3%            | 0.8%-1.3%         |
| C       | less than 100 ppm   | less than 200 ppm    | 0 - 100 ppm       |
| S       | 10 - 35 ppm         | -                    | -                 |
| Si      | less than 50 ppm    | less than 120 ppm    | 0 - 50 ppm        |
| O       | 1100 -1700 ppm      | less than 1600 ppm   | 1100 - 1600 ppm   |
| Zr      | remainder           | remainder            | remainder         |

Sabol et al. ('023) disclose (col. 2, lines 45-68 and col. 1, lines 1-35) adding a third element of iron, chromium, molybdenum, vanadium, copper, nickel and tungsten in amount of up to 0.25% to zirconium-based alloys with 0.5 to 2.0 weight percent niobium that would be made into tubing for nuclear reactors to provide a higher corrosion resistance. In the sample ingot chemistry (Table IV) elements such as tungsten, iron, nickel, copper, and chromium are all present, therefore suggesting to one of ordinary skill that more than one of the third element could be present at one time and that these elements would be functional equivalents (abstract and Table 4). See MPEP 2144.06.

Rebeyrolle et al. ('050) disclose adding sulfur in an amount between 8 ppm and 100 ppm to zirconium-based alloys with 0.7-1.3 weight percent niobium that would be made into tubing sheaths for nuclear reactors to provide improvement in the creep, corrosion and nodular corrosion behaviors (abstract, col. 8, lines 1-30, and col. 9, lines 16-20). The base component compositions of each of these alloys (zirconium and niobium) overlap the composition of the instant invention.

Second, the Applicant argues that Mardon et al. ('995) describe Zircaloy 4 alloys as containing chromium but their corrosion by pressurized water at a high

temperature has limited the length of time they can be kept in a reactor and therefore Mardon et al. ('995) teach against using chromium. The Examiner disagrees. The performance of a Zircaloy 4 alloy would not be considered comparable to the performance of the alloys disclosed by Mardon et al. ('995), Sabol et al. ('023), or Rebeyrolle et al. ('050) because the Zircaloy 4 alloy would not contain niobium whereas the alloys disclosed by all three of these prior art references do.

Third, the Applicant argues that there is no suggestion to limit the tin, carbon and silicon content in the zirconium alloy to 100 ppm or less. The Examiner's position is that the instant claims do not require tin (100 ppm or less), carbon (100 ppm or less), or silicon (50 ppm or less).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, THIS ACTION IS MADE FINAL even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).  
Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessee Roe whose telephone number is (571) 272-5938. The examiner can normally be reached on Monday-Friday 7:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JR

  
ROY KING  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600